

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Patent Application Serial No.: 10/538,856
Attorney Docket No.: 026390-00028

REMARKS

The Office Action dated September 30, 2009 has been received and carefully noted. The above amendments and the following remarks are being submitted as a full and complete response thereto.

Claims 1, 5 and 6 have been rejected. Claims 1, 2, and 5 have been cancelled. Claims 3 and 4 stand withdrawn. Thus, claim 6 is pending in this application. Applicants respectfully request reconsideration and withdrawal of all rejections.

Rejection Under 35 U.S.C. §102

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by Sumitomo Electric Industries, Ltd. (JP 8-165582 A). Claim 1 has been cancelled rendering this rejection moot. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §102(b).

Rejections Under 35 U.S.C. §112

Claims 5, and 6 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claim 5 has been cancelled rendering the rejection of this claim moot. With regard to claim 6, the Examiner contends that "it is not clear wherein the specification a teaching of [...] 'a first means on said matrix for forming a first local cell [...] and a second means on said first means forming a second local cell [...].'"

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Applicants respectfully traverse this rejection as the first and second means, the local cells and their relationship are comprehensively described in the specification as originally filed. In particular, the Applicants respectfully draw the Examiner's attention to at least FIG. 1(b) and its associated description in the text on page 6 of the Specification. The claimed "first means" and "second means" are labeled 2 and 3, respectively. FIG. 1(b) clearly shows local currents flowing in and out of the first means, as claimed (currents are marked with arrows and the words "current" and "electron"). Moreover, "advancing dissolution of the first means" at interfaces between the first means (2) and the matrix material (1) and the second means (3) is also clearly shown in the figure. In fact, FIG. 1(b) explicitly shows "metal ions" being ejected from the first means (2) during the dissolution. The above is described in detail in the instant Specification in the fourth, fifth, sixth and seventh full paragraphs of page 6.

Claims 1, 5, and 6 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1 and 5 have been cancelled rendering the rejections of these claims moot.

In the rejection of claim 6, the Office Action states that the first and second means are unclear because "the specification doesn't describe any actual components or apparatus that positively perform a function on an object" (emphasis added). The Examiner contends that "it is not clear how a means plus function can be used to describe a material of a product since a material is not an apparatus and can not positively perform a function on an object" (emphasis added). Insofar as this line of reasoning is understood, it is respectfully traversed. The Examiner appears to be

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arguing that there is an apparatus positively performing a function on an object requirement for a means-plus-function claim under 35 U.S.C. §112, sixth paragraph. However, the source of this alleged requirement is unclear. The Examiner does not appear to rely on either the MPEP or case law.

In fact, there is no such requirement. MPEP §2181(I) includes an explanation of means-plus-function requirements that does not mention the word “apparatus.” Although the Examiner appears to argue that “a material” cannot provide a proper basis for a means-plus-function claim, MPEP §2181(III) clearly indicates otherwise:

If the corresponding structure, material or acts are described in the specification in specific terms (e.g., an emitter-coupled voltage comparator) and one skilled in the art could identify the structure, material or acts from that description, then the requirements of 35 U.S.C. 112, second and sixth paragraphs and are satisfied. See Atmel, 198 F.3d at 1382, 53 USPQ2d 1231. (emphasis added)

If the argument is properly understood, it seems that the Examiner does not mean to contend that the function is not properly claimed. Rather, the Examiner appears to contend that there is a per se bar against a “material” providing proper basis for a means-plus-function claim. Clearly this contention is contrary to at least MPEP §2181(III) and 35 U.S.C. § 112, sixth paragraph. Moreover, it appears to have no basis in MPEP §2181. If the Applicants’ interpretation is in error, clarification is requested. If the Examiner maintains the alleged apparatus requirement for means-plus-function, the Applicants respectfully request that the Examiner cite the basis for this requirement in the statute, the MPEP or in the case law.

However, even if there *were* a per se apparatus requirement for a means-plus-function claim, Applicants respectfully submit that this requirement would *still* be met by claim 6. FIG. 1 of the instant application clearly shows several versions of an apparatus

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including both the first and second means, as claimed. Therefore, the Examiner's contention that "the specification doesn't describe any actual components or apparatus that positively perform a function on an object" (emphasis added) is clearly incorrect. Moreover, the instant specification makes it clear that the first and second means claimed in claim 6 can be accomplished, not merely by a single material by itself, but by the apparatus shown in FIG. 1. Insofar as the first and second means in claim 6 are mere "materials" they are material layers included in a specific order and location in an apparatus that includes, among other things a multi-layer device immersed in a cleaning fluid S. This configuration gives rise to the "positively perform[ance of] a function on an object," namely the claimed generation of local currents and dissolution of the first means, as claimed and described in FIG. 1 and on page 6 of the Specification. If either of the means were removed, all other things remaining the same, the claimed function would no longer be possible. It is not clear where, or on what basis, the Examiner draws the line between material and apparatus in this case. FIG. 1 clearly shows several versions of an apparatus, not simply a free-standing material or a structure.

The Examiner's contention that only an apparatus can "positively perform a function on an object" is also respectfully disputed. Materials that perform functions on objects are widely known and used in a variety of fields, including not just electrochemistry but also the pharmaceutical and catalytic arts, among others. The rejection seems to be based on the observation that the claimed first and second means correspond to single "material" layers. Yet, the function of these layers is not disputed, nor is it disputed that the layers have specific form and context. It seems that,

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according to the Examiner, no structure made of a single material could ever provide an adequate function to justify means-plus-function language, regardless of the context.

By that reasoning, a screw would not be a proper “means for fastening,” under U.S.C. §112, sixth paragraph, if the screw were fashioned of a single type of material.

Applicants respectfully submit that this interpretation of means-plus-function language has no basis either in the MPEP or in case law. If the Applicants have misinterpreted the Examiner’s position, the Applicants respectfully request that the Examiner clarify this point so that they may better understand the basis for the rejection.

Accordingly, Applicants respectfully request withdrawal of all §112 rejections.

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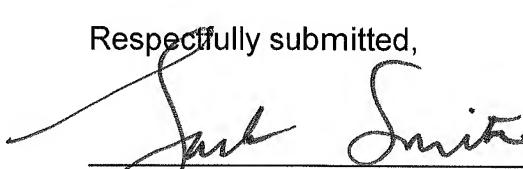
Conclusion

For all of the above reasons, it is respectfully submitted that the pending claims are in condition for allowance and a Notice of Allowability is earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is invited to contact the undersigned representative at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 referencing client matter number 026390-00028.

Respectfully submitted,



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